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FROM: Terry W. Kramer
KRAMER & AMADO, P.C.

DATE: May 24, 2007

SUBJECT: U.S. Patent Application
Title: COMPACT AND LOW-COST SYSTEM FOR RECEIVING
SCRAMBLED SIGNALS FROM A PLURALITY OF
OPERATORS
Serial No.: 10/084,755
Attorney Docket No.: PHFR 010022

PAGES: INCLUDING COVER PAGE (50)

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PTO/SB/21 (09-06)

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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/084,755	RECEIVED CENTRAL FAX CENTER MAY 24 2007
	Filing Date	February 25, 2002	
	First Named Inventor	Herve Bernoit	
	Art Unit	2134	
	Examiner Name	Christopher J. Brown	
Total Number of Pages in This Submission	Attorney Docket Number	PHFR 010022	

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
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Firm Name	Kramer & Amado, P.C.	
Signature	<i>Terry W. Kramer</i>	
Printed name	Terry W. Kramer	
Date	May 24, 2007	Reg. No. 41,541

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FEE TRANSMITTAL
For FY 2007☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 500.00

Complete if Known

Application Number	10/084,755
Filing Date	February 25, 2002
First Named Inventor	Herve Bernoit
Examiner Name	Christopher J. Brown
Art Unit	2134
Attorney Docket No.	PHFR 010022

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Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180
Total Claims	Extra Claims	Fee (\$)
- 20 or HP =	x	=
HP = highest number of total claims paid for, if greater than 20.		
Indep. Claims	Extra Claims	Fee (\$)
- 3 or HP =	x	=
HP = highest number of independent claims paid for, if greater than 3.		
	Fee Paid (\$)	
	Multiple Dependent Claims	
	Fee (\$)	Fee Paid (\$)

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
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SUBMITTED BY

Signature	<i>Terry W. Kramer</i>	Registration No. (Attorney/Agent) 41,541	Telephone 703-519-9801
Name (Print/Type)	Terry W. Kramer	Date May 24, 2007	

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

MAY 24 2007

In re Application of : Herve Bernoit
For : COMPACT AND LOW-COST SYSTEM FOR
RECEIVING SCRAMBLED SIGNALS FROM A
PLURALITY OF OPERATORS
Serial No.: : 10/084,755
Filed : February 25, 2002
Art Unit : 2134
Examiner : Christopher J. Brown
Att. Docket : PHFR 010022
Confirmation No. : 8281

APPEAL BRIEF

Mail Stop Appeal Brief Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed March 30, 2007

I. REAL PARTY IN INTEREST

The party in interest is KONINKLIJKE PHILIPS ELECTRONICS N.V, by way of an
Assignment recorded at Reel 012878, frame 0813.

05/25/2007 TL0111 00000024 10084755

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MAY 24 2007

Application No: 10/084,755
Attorney's Docket No: PHFR 010022**II. RELATED APPEALS AND INTERFERENCES**

Following are identified any prior or pending appeals, interferences or judicial proceedings, known to Appellant, Appellant's representative, or the Assignee, that may be related to, or which will directly affect or be directly affected by or have a bearing upon the Board's decision in the pending appeal:

NONE.

III. STATUS OF CLAIMS

Claims 1-10 are on appeal.

Claims 1-10 are pending.

No claims are allowed.

Claims 1-10 are rejected.

No claims are canceled.

IV. STATUS OF AMENDMENTS

All Amendments have been entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The subject matter recited in claim 1 relates to a system to receive encoded and scrambled data signals and process the signals in order to convert them to output stimuli that can be understood by a user of the system. The system includes a data signal decoder for decompressing

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the data signals, an output device for generating the output stimuli on the basis of output signals from the decoder, descrambling means for descrambling the data signals, said descrambling means being activated by an enabling signal, and enabling means for receiving protected information from a transmitter transmitting the data signals and supplying the enabling signal following the reception of said protective information. The descrambling means executes a conditional access software program for controlling the descrambling of said data signals, said software program being transported to the descrambling means by the enabling signal. *See* page 4, line 20 to page 6, line 32.

The subject matter recited in claim 10 relates to a method of descrambling and decompressing data signals within a system for converting said signals into output stimuli that can be understood by a user of the system, the method comprising transferring a conditional access software program, from enabling means for receiving protected information from a transmitter of data signals, to descrambling means comprising hardware for executing said software program. *See* page 4, line 20 to page 6, line 32.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are presented for review:

A. Claims 1 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,115,821 to Newby, in view of U.S. Patent No. 6,912,513 to Candelore, and further in view of U.S. Patent Publication No. 2002/0001383 to Kasahara.

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B. Claims 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Newby, in view of Candelore, further in view of Kasahara, and still further in view of U.S. Patent No. 5,029,207 to Gammie.

C. Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Newby, in view of Candelore, further in view of Kasahara, and still further in view of "Functional Model of a Conditional Access System" by EBU Project Group (hereinafter "EBU").

D. Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Newby, in view of Candelore, further in view of Kasahara, and still further in view of European Patent No. EP 1168137A1 to Della Valle.

VII. ARGUMENT

A. Rejection of Claims 1 and 10 Under 35 U.S.C. §103(a)

The Final Office Action dated December 4, 2006, rejects claims 1 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Newby, in view of Candelore, and further in view of Kasahara.

Under 35 U.S.C. § 103, the subject matter of a claim is considered obvious, and therefore invalid, when the claimed "subject matter as a whole would have been obvious at the time of the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103. The test for obviousness requires the analysis of four inquiries: 1) the scope and content of the prior art; 2) the differences between the art and the claims at issue; 3) the level of ordinary skill in the art; and 4) secondary considerations which give light to the circumstances surrounding the origin of the subject matter to be patented. *Graham v. John*

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Deere, 383 U.S. 1, 17-18, 148 U.S.P.Q. (BNA) 459, 467 (1966), *cited by KSR Intl. Co. v.*

Teleflex Inc. 550 U.S. ___, slip op. at 2 (2007).

Objective evidence or secondary considerations may include unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. (BNA) at 467. "Evidence developed after the patent grant is not excluded from consideration, for understanding the full range of an invention is not always achieved at the time of filing the patent application." *Knoll Pharmaceutical Co., Inc. v. Teva Pharmaceuticals USA, Inc.* 367 F.3d 1381, 1385, 70 U.S.P.Q.2d (BNA) 1957, 1960 (Fed. Cir. 2004). "It is not improper to obtain additional support consistent with the patented invention, to respond to litigation attacks on validity." *Id.*

"Evidence of secondary considerations, including evidence of unexpected results and commercial success, are but a part of the totality of the evidence that is used to reach the ultimate conclusions of obviousness." *Richardson-Vicks, Inc. v. The Upjohn Co.*, 122 F.3d 1476, 1483, 44 U.S.P.Q.2d (BNA) 1181, 1187 (Fed. Cir. 1997) (*citing Kansas Jack, Inc. v. Kuhn*, 719 F.2d 1144, 1151, 219 U.S.P.Q. (BNA) 857, 862 (Fed. Cir. 1983)). The weight of secondary considerations may be of insufficient weight to override a determination of obviousness based on primary considerations. *Id.* (*citing Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 719, 21 U.S.P.Q.2d (BNA) 1053, 1058 (Fed. Cir. 1991)).

"Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to

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determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *KSR Intl. Co. v. Teleflex Inc.* 550 U.S. ___, slip op. at 14 (2007). Such an analysis should be made explicit to facilitate review. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinnings to support the legal conclusion of obviousness").

In making a determination of obviousness the demonstration of a teaching, suggestion, or motivation to combine known elements constitutes "helpful insight" into the obviousness determination. *See KSR Intl.* 550 U.S. at ___, slip op. at 14; *see also In re Oetiker*, 977 F.2d 1443, 1147, 24 U.S.P.Q.2d (BNA) 1443, 1446 (Fed. Cir. 1992); *see also Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 U.S.P.Q. (BNA) 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986). However, "[t]he obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation or by overemphasis on the importance of published articles and the explicit content of issued patents." 550 U.S. at ___, slip. op. at 15. In contrast to the narrow conception of the obviousness inquiry following a rigid application of the teaching, suggestion, or motivation test, "[w]hat matters is the objective reach of the claim." 550 U.S. at ___, slip. op. at 16.

By focusing on the objective reach of the claim, "[o]ne of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims." *Id.* "[A]ny need or problem known in the field of endeavor at the time of invention and addressed by the patent

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can provide a reason for combining the elements in the manner claimed.” *Id.* The problem address by the prior is not required to be the same as the problem addressed by the patentee. *See id.* Moreover, it is incorrect to assume that “a person of ordinary skill attempting to solve a problem will be led only to those elements of the prior art designed to solve the same problem.” *Id.*; *see In re Wood*, 599 F.2d 1032, 1036-37, 202 U.S.P.Q. (BNA) 171, 174 (C.C.P.A. 1979). Instead, the prior art may be applied for obvious uses outside the primary purposes of the prior art. *See id.*

Applying a flexible approach to the teaching, suggestion or motivation test reverses the prohibition that a patent claim cannot be proved obvious by showing that the combination of elements was “obvious to try.” 550 U.S. at __, slip op. at 17. “When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp.” *Id.*; *see In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 U.S.P.Q. (BNA) 375, 379 (Fed. Cir. 1986) (When combining references “only a reasonable expectation that the beneficial results will be achieved is necessary to show obviousness”).

It is impermissible for an Examiner to engage in hindsight reconstruction of the prior art using Applicant's claims as a template and selecting elements from references to fill the page. Rather, prior art references may be modified or combined to render obvious a subsequent invention only if there was some suggestion or motivation to do so derived from the prior art itself, the nature of the problem to be solved, or the knowledge of one of ordinary skill in the art. *Sibia Neurosciences*, 225 F.3d 1349, 1356 (Fed. Cir. 2000); *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998).

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In order to be directed to unpatentable (i.e., obvious) subject matter, one of two things must be true. Either (1) the references must expressly suggest the claimed combination or imply the same, or (2) the Examiner must present a convincing line of reasoning as to why the applicable artisan would have found the claimed invention to have been obvious in the light of the teachings of the references. The motivation to make a specific structure is not abstract, but practical, and is always related to the properties or uses one skilled in the art would expect the structure to have, if made. The critical inquiry is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making that structure. *See In re Newell*, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See In re Mills*, 916 F.2d 680, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) (holding that, although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so"); *see also In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). Similarly, even if the references relied upon establish that all aspects of the claimed invention were individually known in the art at the time the claimed invention was made, a statement by the Examiner that modifications of the prior art to meet the claimed invention would have been within the ordinary skill of the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *See Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

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Thus, obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). However, the obviousness of the claimed invention "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Thus, "teachings of references can be combined only if there is some suggestion or incentive to do so." *Id.*

Most if not all inventions arise from a combination of old elements. *In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998)). Thus, every element of a claimed invention may often be found in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *Id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination claimed by the applicant. See *In re Sang Su*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002); *In re Kotzab*, 55 USPQ2d at 1316 (citing *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998)); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). Further, "when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference." *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (citing *In re Yates*, 663 F.2d 1054, 211 USPQ 1149, 1151 (CCPA 1981)). "The factual inquiry whether to combine references must be

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thorough and searching." *In re Sang Su*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)).

Here, the Examiner has not conducted the requisite "thorough and searching" factual inquiry. Rather, the Examiner has made no indication whatsoever of where a teaching or suggestion appears in the prior art references that they be combined in the manner necessary to result in the claimed invention.

The Examiner has not alleged that the motivation to combine the references as necessary arrives from the nature of the problem to be solved. In fact, the Examiner alleges motivation to combine Newby with Candelore, as necessary, in order to save compressed data in less space, and a motivation to combine the resulting combination with Kasahara in order to obtain stronger security. These are two completely separate and unsubstantiated motivations.

The "factual question of motivation [to combine references] is material to patentability, and [can] not be resolved on subjective belief and unknown authority." *In re Sang Su*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Here, it appears that the Examiner improperly relies on "subjective belief and unknown authority" to establish the motivation to combine references essential to an obviousness inquiry, because the Examiner has provided no citation within the references themselves, and has provided no factual basis for the allegation that the claimed subject matter would have been obvious to a person having an ordinary level of skill in the art at the time the invention was made.

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"Although the suggestion to combine references may flow from the nature of the problem, 'defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness.'" *Exolochem, Inc. v. Southern Cal. Edison Co.*, 2000 U.S. App. LEXIS 22681, *28 (Fed. Cir. 2000) (citing *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 880, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998)). Thus, "[i]t is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to '[use] that which the inventor taught against its teacher.'" *In re Sang Su*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002) (quoting *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)). "Therefore, when determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus obviousness, of making the combination." *Id.* at *29-30 (citing *In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992)).

Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combining the two, in whatever form, must nevertheless be "clear and particular." *Winner Int'l Royalty Corp. v. Ching-Rong Wang*, 202 F.3d 1340, 1348-49, 53 USPQ2d 1580, 1586-87 (Fed. Cir. 2000) (citations omitted). Here, the prior art contains no such "clear and particular" expression of the desirability of combining the particular teachings contained therein so as to arrive at the claimed combination. Instead, the Examiner relies on impermissible hindsight in reaching a determination of obviousness, defining the problem in terms of its solution.

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A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *See In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." *Kotzab*, 55 USPQ2d at 1316 (quoting *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983) ("[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher")).

It is well settled that "it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to a full appreciation of what such reference fairly suggests to one skilled in the art." *See Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve*, 796 F.2d 443, 448, 230 USPQ 416, 419 (Fed. Cir. 1986) (citing *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 193 (CCPA 1965), cert. denied, 484 U.S. 823 (1987)). Here, this appears to be exactly what the Examiner has done.

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When the only suggestion of a claimed feature on the record is that of the pending application, a rejection under § 103 is improper. *See In re Laskowski*, 10 USPQ2d 1397 (Fed. Cir. 1989). Here, that appears to be the case.

Applicant respectfully asserts that only by the impermissible use of hindsight knowledge of Applicant's own disclosure would the Examiner have acquired a motivation to combine the teachings of the cited references according the precise combination including certain elements and excluding certain others as necessary to achieve the claimed invention.

For at least the foregoing reasons, claims 1 and 10 are patentable over the attenuated combination of three references, Newby, Candelore, and Kasahara.

B. Rejection of Claim 2 Under 35 U.S.C. §103(a)

The Final Office Action dated December 4, 2006, rejects claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Newby, in view of Candelore, and further in view of Kasahara, and still further in view of Gammie.

Under 35 U.S.C. § 103, the subject matter of a claim is considered obvious, and therefore invalid, when the claimed "subject matter as a whole would have been obvious at the time of the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103. The test for obviousness requires the analysis of four inquiries: 1) the scope and content of the prior art; 2) the differences between the art and the claims at issue; 3) the level of ordinary skill in the art; and 4) secondary considerations which give light to the circumstances surrounding the origin of the subject matter to be patented. *Graham v. John Deere*, 383 U.S. 1, 17-18, 148 U.S.P.Q. (BNA) 459, 467 (1966), *cited by KSR Intl. Co. v.*

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Teleflex Inc. 550 U.S. ___, slip op. at 2 (2007).

Objective evidence or secondary considerations may include unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. (BNA) at 467. "Evidence developed after the patent grant is not excluded from consideration, for understanding the full range of an invention is not always achieved at the time of filing the patent application." *Knoll Pharmaceutical Co., Inc. v. Teva Pharmaceuticals USA, Inc.* 367 F.3d 1381, 1385, 70 U.S.P.Q.2d (BNA) 1957, 1960 (Fed. Cir. 2004). "It is not improper to obtain additional support consistent with the patented invention, to respond to litigation attacks on validity." *Id.*

"Evidence of secondary considerations, including evidence of unexpected results and commercial success, are but a part of the totality of the evidence that is used to reach the ultimate conclusions of obviousness." *Richardson-Vicks, Inc. v. The Upjohn Co.*, 122 F.3d 1476, 1483, 44 U.S.P.Q.2d (BNA) 1181, 1187 (Fed. Cir. 1997) (citing *Kansas Jack, Inc. v. Kuhn*, 719 F.2d 1144, 1151, 219 U.S.P.Q. (BNA) 857, 862 (Fed. Cir. 1983)). The weight of secondary considerations may be of insufficient weight to override a determination of obviousness based on primary considerations. *Id.* (citing *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 719, 21 U.S.P.Q.2d (BNA) 1053, 1058 (Fed. Cir. 1991)).

"Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion

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claimed by the patent at issue.” *KSR Intl. Co. v. Teleflex Inc.* 550 U.S. ___, slip op. at 14 (2007). Such an analysis should be made explicit to facilitate review. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinnings to support the legal conclusion of obviousness”).

In making a determination of obviousness the demonstration of a teaching, suggestion, or motivation to combine known elements constitutes “helpful insight” into the obviousness determination. *See KSR Intl.* 550 U.S. at ___, slip op. at 14; *see also In re Oetiker*, 977 F.2d 1443, 1147, 24 U.S.P.Q.2d (BNA) 1443, 1446 (Fed. Cir. 1992); *see also Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 U.S.P.Q. (BNA) 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986). However, “[t]he obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation or by overemphasis on the importance of published articles and the explicit content of issued patents.” 550 U.S. at ___, slip. op. at 15. In contrast to the narrow conception of the obviousness inquiry following a rigid application of the teaching, suggestion, or motivation test, “[w]hat matters is the objective reach of the claim.” 550 U.S. at ___, slip. op. at 16.

By focusing on the objective reach of the claim, “[o]ne of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *Id.* “[A]ny need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *Id.* The problem address

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by the prior is not required to be the same as the problem addressed by the patentee. *See id.* Moreover, it is incorrect to assume that "a person of ordinary skill attempting to solve a problem will be led only to those elements of the prior art designed to solve the same problem." *Id.*; *see In re Wood*, 599 F.2d 1032, 1036-37, 202 U.S.P.Q. (BNA) 171, 174 (C.C.P.A. 1979). Instead, the prior art may be applied for obvious uses outside the primary purposes of the prior art. *See id.*

Applying a flexible approach to the teaching, suggestion or motivation test reverses the prohibition that a patent claim cannot be proved obvious by showing that the combination of elements was "obvious to try." 550 U.S. at __, slip op. at 17. "When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp." *Id.*; *see In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 U.S.P.Q. (BNA) 375, 379 (Fed. Cir. 1986) (When combining references "only a reasonable expectation that the beneficial results will be achieved is necessary to show obviousness").

It is impermissible for an Examiner to engage in hindsight reconstruction of the prior art using Applicant's claims as a template and selecting elements from references to fill the page. Rather, prior art references may be modified or combined to render obvious a subsequent invention only if there was some suggestion or motivation to do so derived from the prior art itself, the nature of the problem to be solved, or the knowledge of one of ordinary skill in the art. *Sibia Neurosciences*, 225 F.3d 1349, 1356 (Fed. Cir. 2000); *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998).

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In order to be directed to unpatentable (i.e., obvious) subject matter, one of two things must be true. Either (1) the references must expressly suggest the claimed combination or imply the same, or (2) the Examiner must present a convincing line of reasoning as to why the applicable artisan would have found the claimed invention to have been obvious in the light of the teachings of the references. The motivation to make a specific structure is not abstract, but practical, and is always related to the properties or uses one skilled in the art would expect the structure to have, if made. The critical inquiry is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making that structure. *See In re Newell*, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See In re Mills*, 916 F.2d 680, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) (holding that, although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so"); *see also In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). Similarly, even if the references relied upon establish that all aspects of the claimed invention were individually known in the art at the time the claimed invention was made, a statement by the Examiner that modifications of the prior art to meet the claimed invention would have been within the ordinary skill of the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *See Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

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Thus, obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). However, the obviousness of the claimed invention "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Thus, "teachings of references can be combined only if there is some suggestion or incentive to do so." *Id.*

Most if not all inventions arise from a combination of old elements. *In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998)). Thus, every element of a claimed invention may often be found in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *Id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination claimed by the applicant. See *In re Sang Su*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002); *In re Kotzab*, 55 USPQ2d at 1316 (citing *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998)); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). Further, "when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference." *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (citing *In re Yates*, 663 F.2d 1054, 211 USPQ 1149, 1151 (CCPA 1981)). "The factual inquiry whether to combine references must be

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thorough and searching." *In re Sang Su*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)).

Here, the Examiner has not conducted the requisite "thorough and searching" factual inquiry. Rather, the Examiner has made no indication whatsoever of where a teaching or suggestion appears in the prior art references that they be combined in the manner necessary to result in the claimed invention.

The Examiner has not alleged that the motivation to combine the references as necessary arrives from the nature of the problem to be solved. In fact, in connection with the subject matter recited in claim 2, the Examiner alleges 1) a motivation to combine Newby with Candelore, as necessary, in order to save compressed data in less space, 2) a motivation to combine the resulting combination with Kasahara in order to obtain stronger security, and 3) a motivation to further combine the resulting combination with Gammie in order to reduce size and improve efficiency. These are three completely separate and unsubstantiated motivations for combining selected disclosure in four different references.

The "factual question of motivation [to combine references] is material to patentability, and [can] not be resolved on subjective belief and unknown authority." *In re Sang Su*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Here, it appears that the Examiner improperly relies on "subjective belief and unknown authority" to establish the motivation to combine references essential to an obviousness inquiry, because the Examiner has provided no citation within the references themselves, and has provided no factual basis for the allegation that the claimed

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subject matter would have been obvious to a person having an ordinary level of skill in the art at the time the invention was made.

"Although the suggestion to combine references may flow from the nature of the problem, 'defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness.'" *Exolochem, Inc. v. Southern Cal. Edison Co.*, 2000 U.S. App. LEXIS 22681, *28 (Fed. Cir. 2000) (citing *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 880, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998)). Thus, "[i]t is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to '[use] that which the inventor taught against its teacher.'" *In re Sang Su*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002) (quoting *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)). "Therefore, when determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus obviousness, of making the combination." *Id.* at *29-30 (citing *In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992)).

Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combining the two, in whatever form, must nevertheless be "clear and particular." *Winner Int'l Royalty Corp. v. Ching-Rong Wang*, 202 F.3d 1340, 1348-49, 53 USPQ2d 1580, 1586-87 (Fed. Cir. 2000) (citations omitted). Here, the prior art contains no such "clear and particular" expression of the desirability of combining the particular teachings contained therein so as to arrive at the claimed combination. Instead, the

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Examiner relies on impermissible hindsight in reaching a determination of obviousness, defining the problem in terms of its solution.

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *See In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." *Kotzab*, 55 USPQ2d at 1316 (quoting *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983) ("[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher")).

It is well settled that "it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to a full appreciation of what such reference fairly suggests to one skilled in the art." *See Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve*, 796 F.2d 443, 448, 230 USPQ 416, 419 (Fed. Cir. 1986) (citing *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391,

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193 (CCPA 1965), cert. denied, 484 U.S. 823 (1987)). Here, this appears to be exactly what the Examiner has done.

When the only suggestion of a claimed feature on the record is that of the pending application, a rejection under § 103 is improper. *See In re Laskowski*, 10 USPQ2d 1397 (Fed. Cir. 1989). Here, that appears to be the case.

Applicant respectfully asserts that only by the impermissible use of hindsight knowledge of Applicant's own disclosure would the Examiner have acquired a motivation to combine the teachings of the cited references according the precise combination including certain elements and excluding certain others as necessary to achieve the claimed invention.

For at least the foregoing reasons, claim 2 is patentable over the attenuated combination of four references, Newby, Candelore, Kasahara and Gammie.

C. Rejection of Claim 4 Under 35 U.S.C. §103(a)

The Final Office Action dated December 4, 2006, rejects claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Newby, in view of Candelore, further in view of Kasahara, and still further in view of EBU.

Under 35 U.S.C. § 103, the subject matter of a claim is considered obvious, and therefore invalid, when the claimed "subject matter as a whole would have been obvious at the time of the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103. The test for obviousness requires the analysis of four inquiries: 1) the scope and content of the prior art; 2) the differences between the art and the claims at issue; 3) the level of ordinary skill in the art; and 4) secondary considerations which give light to the

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circumstances surrounding the origin of the subject matter to be patented. *Graham v. John Deere*, 383 U.S. 1, 17-18, 148 U.S.P.Q. (BNA) 459, 467 (1966), cited by *KSR Intl. Co. v. Teleflex Inc.* 550 U.S. ___, slip op. at 2 (2007).

Objective evidence or secondary considerations may include unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. (BNA) at 467. "Evidence developed after the patent grant is not excluded from consideration, for understanding the full range of an invention is not always achieved at the time of filing the patent application." *Knoll Pharmaceutical Co., Inc. v. Teva Pharmaceuticals USA, Inc.* 367 F.3d 1381, 1385, 70 U.S.P.Q.2d (BNA) 1957, 1960 (Fed. Cir. 2004). "It is not improper to obtain additional support consistent with the patented invention, to respond to litigation attacks on validity." *Id.*

"Evidence of secondary considerations, including evidence of unexpected results and commercial success, are but a part of the totality of the evidence that is used to reach the ultimate conclusions of obviousness." *Richardson-Vicks, Inc. v. The Upjohn Co.*, 122 F.3d 1476, 1483, 44 U.S.P.Q.2d (BNA) 1181, 1187 (Fed. Cir. 1997) (citing *Kansas Jack, Inc. v. Kuhn*, 719 F.2d 1144, 1151, 219 U.S.P.Q. (BNA) 857, 862 (Fed. Cir. 1983)). The weight of secondary considerations may be of insufficient weight to override a determination of obviousness based on primary considerations. *Id.* (citing *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 719, 21 U.S.P.Q.2d (BNA) 1053, 1058 (Fed. Cir. 1991)).

"Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the

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background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *KSR Intl. Co. v. Teleflex Inc.* 550 U.S. ___, slip op. at 14 (2007). Such an analysis should be made explicit to facilitate review. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinnings to support the legal conclusion of obviousness").

In making a determination of obviousness the demonstration of a teaching, suggestion, or motivation to combine known elements constitutes "helpful insight" into the obviousness determination. *See KSR Intl.* 550 U.S. at ___, slip op. at 14; *see also In re Oetiker*, 977 F.2d 1443, 1147, 24 U.S.P.Q.2d (BNA) 1443, 1446 (Fed. Cir. 1992); *see also Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 U.S.P.Q. (BNA) 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986). However, "[t]he obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation or by overemphasis on the importance of published articles and the explicit content of issued patents." 550 U.S. at ___, slip. op. at 15. In contrast to the narrow conception of the obviousness inquiry following a rigid application of the teaching, suggestion, or motivation test, "[w]hat matters is the objective reach of the claim." 550 U.S. at ___, slip. op. at 16.

By focusing on the objective reach of the claim, "[o]ne of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims." *Id.* "[A]ny

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need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *Id.* The problem address by the prior is not required to be the same as the problem addressed by the patentee. *See id.* Moreover, it is incorrect to assume that "a person of ordinary skill attempting to solve a problem will be led only to those elements of the prior art designed to solve the same problem." *Id.*; *see In re Wood*, 599 F.2d 1032, 1036-37, 202 U.S.P.Q. (BNA) 171, 174 (C.C.P.A. 1979). Instead, the prior art may be applied for obvious uses outside the primary purposes of the prior art. *See id.*

Applying a flexible approach to the teaching, suggestion or motivation test reverses the prohibition that a patent claim cannot be proved obvious by showing that the combination of elements was "obvious to try." 550 U.S. at __, slip op. at 17. "When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp." *Id.*; *see In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 U.S.P.Q. (BNA) 375, 379 (Fed. Cir. 1986) (When combining references "only a reasonable expectation that the beneficial results will be achieved is necessary to show obviousness").

It is impermissible for an Examiner to engage in hindsight reconstruction of the prior art using Applicant's claims as a template and selecting elements from references to fill the page. Rather, prior art references may be modified or combined to render obvious a subsequent invention only if there was some suggestion or motivation to do so derived from the prior art itself, the nature of the problem to be solved, or the knowledge of one of ordinary skill in the art.

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Sibia Neurosciences, 225 F.3d 1349, 1356 (Fed. Cir. 2000); *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998).

In order to be directed to unpatentable (i.e., obvious) subject matter, one of two things must be true. Either (1) the references must expressly suggest the claimed combination or imply the same, or (2) the Examiner must present a convincing line of reasoning as to why the applicable artisan would have found the claimed invention to have been obvious in the light of the teachings of the references. The motivation to make a specific structure is not abstract, but practical, and is always related to the properties or uses one skilled in the art would expect the structure to have, if made. The critical inquiry is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making that structure. *See In re Newell*, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See In re Mills*, 916 F.2d 680, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) (holding that, although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so"); *see also In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). Similarly, even if the references relied upon establish that all aspects of the claimed invention were individually known in the art at the time the claimed invention was made, a statement by the Examiner that modifications of the prior art to meet the claimed invention would have been within the ordinary skill of the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the

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teachings of the references. *See Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

Thus, obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). However, the obviousness of the claimed invention "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Thus, "teachings of references can be combined only if there is some suggestion or incentive to do so." *Id.*

Most if not all inventions arise from a combination of old elements. *In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998)). Thus, every element of a claimed invention may often be found in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *Id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination claimed by the applicant. *See In re Sang Su*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002); *In re Kotzab*, 55 USPQ2d at 1316 (citing *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998)); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). Further, "when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference." *In*

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re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (citing *In re Yates*, 663 F.2d 1054, 211 USPQ 1149, 1151 (CCPA 1981)). "The factual inquiry whether to combine references must be thorough and searching." *In re Sang Su*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)).

Here, the Examiner has not conducted the requisite "thorough and searching" factual inquiry. Rather, the Examiner has made no indication whatsoever of where a teaching or suggestion appears in the prior art references that they be combined in the manner necessary to result in the claimed invention.

The Examiner has not alleged that the motivation to combine the references as necessary arrives from the nature of the problem to be solved. In fact, in connection with the subject matter recited in claim 4, the Examiner alleges 1) a motivation to combine Newby with Candelore, as necessary, in order to save compressed data in less space, 2) a motivation to combine the resulting combination with Kasahara in order to obtain stronger security, and 3) a motivation to further combine the resulting combination with EBU in order to reduce size and improve user friendliness. These are three completely separate and unsubstantiated motivations for combining selected disclosure in four different references.

The "factual question of motivation [to combine references] is material to patentability, and [can] not be resolved on subjective belief and unknown authority." *In re Sang Su*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Here, it appears that the Examiner improperly relies on "subjective belief and unknown authority" to establish the motivation to combine references

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essential to an obviousness inquiry, because the Examiner has provided no citation within the references themselves, and has provided no factual basis for the allegation that the claimed subject matter would have been obvious to a person having an ordinary level of skill in the art at the time the invention was made.

"Although the suggestion to combine references may flow from the nature of the problem, 'defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness.'" *Exolochem, Inc. v. Southern Cal. Edison Co.*, 2000 U.S. App. LEXIS 22681, *28 (Fed. Cir. 2000) (citing *Monarch Knitting Mach. Corp. v. Sulzer Morat Gmbh*, 139 F.3d 877, 880, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998)). Thus, "[i]t is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to '[use] that which the inventor taught against its teacher.'" *In re Sang Su*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002) (quoting *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)). "Therefore, when determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus obviousness, of making the combination." *Id.* at *29-30 (citing *In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992)).

Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combining the two, in whatever form, must nevertheless be "clear and particular." *Winner Int'l Royalty Corp. v. Ching-Rong Wang*, 202 F.3d 1340, 1348-49, 53 USPQ2d 1580, 1586-87 (Fed. Cir. 2000) (citations omitted). Here, the prior

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art contains no such "clear and particular" expression of the desirability of combining the particular teachings contained therein so as to arrive at the claimed combination. Instead, the Examiner relies on impermissible hindsight in reaching a determination of obviousness, defining the problem in terms of its solution.

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *See In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." *Kotzab*, 55 USPQ2d at 1316 (quoting *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983) ("[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher")).

It is well settled that "it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to a full appreciation of what such reference fairly suggests to one skilled in the art." *See Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve*, 796 F.2d 443, 448,

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230 USPQ. 416, 419 (Fed. Cir. 1986) (citing *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 193 (CCPA 1965), cert. denied, 484 U.S. 823 (1987)). Here, this appears to be exactly what the Examiner has done.

When the only suggestion of a claimed feature on the record is that of the pending application, a rejection under § 103 is improper. See *In re Laskowski*, 10 USPQ2d 1397 (Fed. Cir. 1989). Here, that appears to be the case.

Applicant respectfully asserts that only by the impermissible use of hindsight knowledge of Applicant's own disclosure would the Examiner have acquired a motivation to combine the teachings of the cited references according the precise combination including certain elements and excluding certain others as necessary to achieve the claimed invention.

For at least the foregoing reasons, claim 4 is patentable over the attenuated combination of four references, Newby, Candelore, Kasahara and EBU.

D. Rejection of Claim 7 Under 35 U.S.C. §103(a)

The Final Office Action dated December 4, 2006, rejects claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Newby, in view of Candelore, further in view of Kasahara, and still further in view of Della Valle.

Under 35 U.S.C. § 103, the subject matter of a claim is considered obvious, and therefore invalid, when the claimed "subject matter as a whole would have been obvious at the time of the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103. The test for obviousness requires the analysis of four inquiries: 1) the scope and content of the prior art; 2) the differences between the art and the claims at issue;

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3) the level of ordinary skill in the art; and 4) secondary considerations which give light to the circumstances surrounding the origin of the subject matter to be patented. *Graham v. John Deere*, 383 U.S. 1, 17-18, 148 U.S.P.Q. (BNA) 459, 467 (1966), cited by *KSR Intl. Co. v. Teleflex Inc.* 550 U.S. ___, slip op. at 2 (2007).

Objective evidence or secondary considerations may include unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. (BNA) at 467. "Evidence developed after the patent grant is not excluded from consideration, for understanding the full range of an invention is not always achieved at the time of filing the patent application." *Knoll Pharmaceutical Co., Inc. v. Teva Pharmaceuticals USA, Inc.* 367 F.3d 1381, 1385, 70 U.S.P.Q.2d (BNA) 1957, 1960 (Fed. Cir. 2004). "It is not improper to obtain additional support consistent with the patented invention, to respond to litigation attacks on validity." *Id.*

"Evidence of secondary considerations, including evidence of unexpected results and commercial success, are but a part of the totality of the evidence that is used to reach the ultimate conclusions of obviousness." *Richardson-Vicks, Inc. v. The Upjohn Co.*, 122 F.3d 1476, 1483, 44 U.S.P.Q.2d (BNA) 1181, 1187 (Fed. Cir. 1997) (citing *Kansas Jack, Inc. v. Kuhn*, 719 F.2d 1144, 1151, 219 U.S.P.Q. (BNA) 857, 862 (Fed. Cir. 1983)). The weight of secondary considerations may be of insufficient weight to override a determination of obviousness based on primary considerations. *Id.* (citing *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 719, 21 U.S.P.Q.2d (BNA) 1053, 1058 (Fed. Cir. 1991)).

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"Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *KSR Intl. Co. v. Teleflex Inc.* 550 U.S. ___, slip op. at 14 (2007). Such an analysis should be made explicit to facilitate review. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinnings to support the legal conclusion of obviousness").

In making a determination of obviousness the demonstration of a teaching, suggestion, or motivation to combine known elements constitutes "helpful insight" into the obviousness determination. *See KSR Intl.* 550 U.S. at ___, slip op. at 14; *see also In re Oetiker*, 977 F.2d 1443, 1147, 24 U.S.P.Q.2d (BNA) 1443, 1446 (Fed. Cir. 1992); *see also Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 U.S.P.Q. (BNA) 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986). However, "[t]he obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation or by overemphasis on the importance of published articles and the explicit content of issued patents." 550 U.S. at ___, slip. op. at 15. In contrast to the narrow conception of the obviousness inquiry following a rigid application of the teaching, suggestion, or motivation test, "[w]hat matters is the objective reach of the claim." 550 U.S. at ___, slip. op. at 16.

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By focusing on the objective reach of the claim, "[o]ne of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims." *Id.* "[A]ny need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *Id.* The problem address by the prior is not required to be the same as the problem addressed by the patentee. *See id.* Moreover, it is incorrect to assume that "a person of ordinary skill attempting to solve a problem will be led only to those elements of the prior art designed to solve the same problem." *Id.*; *see In re Wood*, 599 F.2d 1032, 1036-37, 202 U.S.P.Q. (BNA) 171, 174 (C.C.P.A. 1979). Instead, the prior art may be applied for obvious uses outside the primary purposes of the prior art. *See id.*

Applying a flexible approach to the teaching, suggestion or motivation test reverses the prohibition that a patent claim cannot be proved obvious by showing that the combination of elements was "obvious to try." 550 U.S. at __, slip op. at 17. "When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp." *Id.*; *see In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 U.S.P.Q. (BNA) 375, 379 (Fed. Cir. 1986) (When combining references "only a reasonable expectation that the beneficial results will be achieved is necessary to show obviousness").

It is impermissible for an Examiner to engage in hindsight reconstruction of the prior art using Applicant's claims as a template and selecting elements from references to fill the page. Rather, prior art references may be modified or combined to render obvious a subsequent

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invention only if there was some suggestion or motivation to do so derived from the prior art itself, the nature of the problem to be solved, or the knowledge of one of ordinary skill in the art. *Sibia Neurosciences*, 225 F.3d 1349, 1356 (Fed. Cir. 2000); *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998).

In order to be directed to unpatentable (i.e., obvious) subject matter, one of two things must be true. Either (1) the references must expressly suggest the claimed combination or imply the same, or (2) the Examiner must present a convincing line of reasoning as to why the applicable artisan would have found the claimed invention to have been obvious in the light of the teachings of the references. The motivation to make a specific structure is not abstract, but practical, and is always related to the properties or uses one skilled in the art would expect the structure to have, if made. The critical inquiry is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making that structure. *See In re Newell*, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See In re Mills*, 916 F.2d 680, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) (holding that, although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so"); *see also In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). Similarly, even if the references relied upon establish that all aspects of the claimed invention were individually known in the art at the time the claimed invention was made, a statement by the Examiner that modifications of the prior art to meet the

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claimed invention would have been within the ordinary skill of the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *See Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

Thus, obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). However, the obviousness of the claimed invention "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Thus, "teachings of references can be combined only if there is some suggestion or incentive to do so." *Id.*

Most if not all inventions arise from a combination of old elements. *In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998)). Thus, every element of a claimed invention may often be found in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *Id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination claimed by the applicant. *See In re Sang Su*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002); *In re Kotzab*, 55 USPQ2d at 1316 (citing *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998)); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir.

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1984)). Further, "when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference." *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (citing *In re Yates*, 663 F.2d 1054, 211 USPQ 1149, 1151 (CCPA 1981)). "The factual inquiry whether to combine references must be thorough and searching." *In re Sang Su*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)).

Here, the Examiner has not conducted the requisite "thorough and searching" factual inquiry. Rather, the Examiner has made no indication whatsoever of where a teaching or suggestion appears in the prior art references that they be combined in the manner necessary to result in the claimed invention.

The Examiner has not alleged that the motivation to combine the references as necessary arrives from the nature of the problem to be solved. In fact, in connection with the subject matter recited in claim 7, the Examiner alleges 1) a motivation to combine Newby with Candelore, as necessary, in order to save compressed data in less space, 2) a motivation to combine the resulting combination with Kasahara in order to obtain stronger crypto system, and 3) a motivation to further combine the resulting combination with Della Valla in order to prevent unwanted users from accessing the system. These are three completely separate and unsubstantiated motivations for combining selected disclosure in four different references.

The "factual question of motivation [to combine references] is material to patentability, and [can] not be resolved on subjective belief and unknown authority." *In re Sang Su*, 277 F.3d

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1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Here, it appears that the Examiner improperly relies on "subjective belief and unknown authority" to establish the motivation to combine references essential to an obviousness inquiry, because the Examiner has provided no citation within the references themselves, and has provided no factual basis for the allegation that the claimed subject matter would have been obvious to a person having an ordinary level of skill in the art at the time the invention was made.

"Although the suggestion to combine references may flow from the nature of the problem, 'defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness.'" *Exolochem, Inc. v. Southern Cal. Edison Co.*, 2000 U.S. App. LEXIS 22681, *28 (Fed. Cir. 2000) (citing *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 880, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998)). Thus, "[i]t is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to '[use] that which the inventor taught against its teacher.'" *In re Sang Su*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002) (quoting *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)). "Therefore, when determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus obviousness, of making the combination." *Id.* at *29-30 (citing *In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992)).

Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combining the two, in whatever form, must

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nevertheless be "clear and particular." *Winner Int'l Royalty Corp. v. Ching-Rong Wang*, 202 F.3d 1340, 1348-49, 53 USPQ2d 1580, 1586-87 (Fed. Cir. 2000) (citations omitted). Here, the prior art contains no such "clear and particular" expression of the desirability of combining the particular teachings contained therein so as to arrive at the claimed combination. Instead, the Examiner relies on impermissible hindsight in reaching a determination of obviousness, defining the problem in terms of its solution.

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See *In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." *Kotzab*, 55 USPQ2d at 1316 (quoting *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983) ("[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher")).

It is well settled that "it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the

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exclusion of other parts necessary to a full appreciation of what such reference fairly suggests to one skilled in the art." *See Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve*, 796 F.2d 443, 448, 230 USPQ 416, 419 (Fed. Cir. 1986) (citing *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 193 (CCPA 1965), cert. denied, 484 U.S. 823 (1987)). Here, this appears to be exactly what the Examiner has done.

When the only suggestion of a claimed feature on the record is that of the pending application, a rejection under § 103 is improper. *See In re Laskowski*, 10 USPQ2d 1397 (Fed. Cir. 1989). Here, that appears to be the case.

Applicant respectfully asserts that only by the impermissible use of hindsight knowledge of Applicant's own disclosure would the Examiner have acquired a motivation to combine the teachings of the cited references according the precise combination including certain elements and excluding certain others as necessary to achieve the claimed invention.

For at least the foregoing reasons, claim 7 is patentable over the attenuated combination of four references, Newby, Candelore, Kasahara and Della Valle.

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CONCLUSION

For at least the reasons discussed above, it is respectfully submitted that the rejections are in error and that claims 1-10 are in condition for allowance. For at least the above reasons, Appellants respectfully request that this Honorable Board reverse the rejections of claims 1-10.

Respectfully submitted,
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May 24, 2007
Date

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VIII. CLAIMS APPENDIX

CLAIMS INVOLVED IN THE APPEAL:

1. A system to receive encoded and scrambled data signals and process the signals in order to convert them to output stimuli that can be understood by a user of the system, the system comprising:

a data signal decoder for decompressing the data signals;

an output device for generating the output stimuli on the basis of output signals from the decoder;

descrambling means for descrambling the data signals, said descrambling means being activated by an enabling signal; and

enabling means for receiving protected information from a transmitter transmitting the data signals and supplying the enabling signal following the reception of said protective information,

wherein the descrambling means execute a conditional access software program for controlling the descrambling of said data signals, said software program being transported to the descrambling means by the enabling signal.

2. A system as claimed in claim 1, wherein the descrambling means are included in the decoder.

3. A system as claimed in claim 1, wherein the enabling means are included in the decoder.

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4. A system as claimed in claim 1, wherein the decoder is included in the output device.
5. A system as claimed in claim 2, wherein the decoder includes an interface to enable data to be exchanged with peripheral equipment, and wherein the conditional access software program is transferred from the enabling means to the descrambling means via the interface by the enabling signal.
6. A system as claimed in claim 1, wherein the enabling means comprise a memory for storing the protected information including said conditional access software program for controlling the descrambling.
7. A system as claimed in claim 1, wherein the enabling means include a detachable memory medium reader, the protected information being stored in a memory of the medium.
8. A system as claimed in claim 7, wherein the detachable memory medium is a chip card.
9. A system as claimed in claim 1, wherein the enabling means are provided with a modem enabling a real-time data exchange between the system and a transmitter of data signals.
10. A method of descrambling and decompressing data signals within a system for converting said signals into output stimuli that can be understood by a user of the system, the method comprising transferring a conditional access software program, from enabling means for

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receiving protected information from a transmitter of data signals, to descrambling means
comprising hardware for executing said software program.

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IX. EVIDENCE APPENDIX

A copy of the following evidence 1) entered by the Examiner, including a statement setting forth where in the record the evidence was entered by the Examiner, 2) relied upon by the Appellant in the appeal, and/or 3) relied upon by the Examiner as to the grounds of rejection to be reviewed on appeal, is attached:

None.

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X. RELATED PROCEEDINGS APPENDIX

Copies of relevant decisions in prior or pending appeals, interferences or judicial proceedings, known to Appellant, Appellant's representative, or the Assignee, that may be related to, or which will directly affect or be directly affected by or have a bearing upon the Board's decision in the pending appeal are attached:

None.